

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant(s): Wisniewski et al.

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Examiner: Walsh, John B.

Title: Communication Tagging

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Customer No.: 29,683

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Reply Brief

Sir:

This is in reply to the Examiner's Answer mailed 04/27/2010 in regard to the above-identified patent application.

On Page 11 of the Examiner's Answer, the examiner indicates that the information discussed in Paragraphs 0032 and 0033 of Reed et al. satisfies as a "task tag". In regard to "task tag", the examiner states that:

"The term has not been given any particular definition as set forth in the claim and limitations from the specification are not read into the claim. Furthermore the appellant has not provided any evidence that the term "task tag" inherently carries a particular definition to one of ordinary skill in the art. Therefore given the

broadest reasonable interpretation Reed et al. anticipates the claimed "task tag" since the information being transmitted/received accomplishes the same function set forth in the claim."

This typifies the main reason this application is up on appeal to the Board. As noted in MPEP 2111, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." However, it appears that the examiner's interpretation is not "reasonable" **because it is not consistent with the specification.** Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from 'reading limitations of the specification into a claim,' to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. (see *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969) noted in MPEP 2111). The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999) cited in MPEP 2111.

As noted in the background section of the patent application:

[0003] It is important in the workplace to be able to track both individual and team progress. Tracking and reporting deliverables and tasks decided on via communication among individuals is critical to teams and individuals who need to summarize and present their work periodically to others, including 1) team leaders and

project leaders who need to understand and be able to act and react to changes in project status, and 2) project managers who need to decide where to allocate resources. Existing in the marketplace today are 1) simple calendar programs that provide individuals with the ability to add action items such as calendar entries and to generate reminders for action items and 2) Programs like Microsoft Project, which can provide project managers with the status of a project. Neither of these existing programs, nor other such programs, are well integrated into common forms of communication in the workplace.

In the present case, "task tag" is described in the specification with reference to a "task tag icon 52" and a "task tag entry window 54" (see paragraph [0028] and end of paragraph [0027]). Paragraph [0028] clearly describes that:

"The task tag entry window 54 generally comprises a deliverable or project field 55, a task topic field 56, a time to task field 58, a task progress field 60, a reminder interval field 62, a collaborator type field 64, a task priority field 66, an OK icon 68, a Clear icon 70, an Edit Defaults icon 72, and drop-down field selection icons 74. The user can enter tag information into the fields 55-66 or select tag information to be entered into the fields by use of the drop-down menus when icons 74 are used."

Note also the description in paragraphs [0029-0031]:

[0029] The task topics for the task topic field 56 are preferably subcategories or subprojects of the

deliverable or project in the project field 55. The project field 55 could be automatically filled, such as when a user is only working on one project. The task topic field 56 could be automatically filed, such as when a user is only working on one task of a project. The user can enter a deliverable or project in the project filed 55 or select the project from a drop down list. For example, the project could be delivering a product to a customer and the task topics could comprise subprojects such as design of the product, bidding from subcontractors to deliver goods to make the product, assembly of the product, various quality control checks of the product, and delivery of the product to the customer. This is only an example. A deliverable or project could comprise hundreds of task topics for that project. Tracking of the deliverable or project could be monitored by tracking the task topics.

[0030] In the embodiment shown in Fig. 2, the choices available for the tag properties or tag setting are set by the Initiator as indicated by block 20. This can be done when the user creates an email and uses the Task Tag icon as described above. The task tag properties or settings can include:

task topic;

time to task completion;

task progress;

reminder interval;

collaborator type; and

task priority.

[0031] The tag properties or setting could include less, or additional, or alternative properties or setting. The task topic identified the task or project. This is used for correlating the email with other information or emails related to the same task topic. The time to task completion can be a specific date or can be a relative date of when a task of the task topic is expected to be completed. The task progress setting can include progress identifiers for the progress of the task of the task topic. For example, choices for the task progress could include 'previous', 'new', 'in-progress', 'complete', 'other', 'merge', 'separate'. This could be provided through a pull-down menu. In the collaborator type setting, the Initiator can identify himself or herself according to a collaborator type. The collaborator type can include, for example, choices such as 'individual', 'collaborator', 'team leader', 'manager', 'senior manager', 'vice-president', 'CEO', 'CIO', 'contractor'. This could be provided through a pull-down menu. The task priority can be used to prioritize the task of the task topic relative to other tasks. For example, the task priority setting could include, choices such as 'low priority', 'high priority', 'urgent', 'ASAP', 'performance review'. This could be provided through a pull-down menu.

The examiner has admitted that the term "task tag" "...has not been given any particular definition... and limitations from the

specification are not read into the claims. As noted above, reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from "reading limitations of the specification into a claim". The examiner has committed an error by failing to read the claim limitation "task tag" in light of the specification, to thereby interpret the limitation "task tag" explicitly recited in the claims. A person skilled in the art, after reading applicants' patent application would clearly not consider Reed et al. as disclosing or suggestion any type of "task tag" as used in applicants' claims. The examiner has not been giving the claim limitation "task tag" a **reasonable** claim limitation in view of the description in the specification. The examiner's interpretation appears unreasonable in view of the description in the specification. Applicants' are not asking that limitations of the specification be read into a claim. Applicants' are merely asking that the claims be read in light of the specification, to thereby interpret limitations explicitly recited in the claim. The examiner has committed reversible error by failing to read the claim language "task tag" in light of the specification.

In the Examiner's Answer, for the first time, the examiner now mentions "inherent" in some of his comments (see the discussion of claim 2 on page 12 of the Examiner's Answer for example). MPEP 2112 discusses inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior

art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) Contrary to what the examiner has stated, dissemination of the "changed information" mentioned in paragraph [0090] of Reed et al. is not an inherent feature that a program is configured to determine if an email has a task tag.

As further evidence that the examiner has not been using a proper "broadest reasonable interpretation" standard can be found on page 12 of the Examiner's Answer. In discussing claim 3 the examiner indicates that:

"... "task topic" and "task reminder" have not be defined in the claim and limitations from the specification are not read into the claim. The "task topic" and "task reminder" appear to be merely labels."

This is clear evidence that the examiner has committed reversible error. Stating that "task topic" and "task reminder" appear to be merely labels is contrary to the examiner's duty to review the patentability of the claims when the claim language is read in light of the specification. The examiner's interpretation of the claim language is unreasonable. For example, paragraph [0029] of the application describes:

[0029] The task topics for the task topic field 56 are preferably subcategories or subprojects of the deliverable or project in the project field 55. The project field 55 could be automatically filled, such as when a user is only working on one project. The task topic field 56 could be automatically filed, such as when

a user is only working on one task of a project. The user can enter a deliverable or project in the project filed 55 or select the project from a drop down list. For example, the project could be delivering a product to a customer and the task topics could comprise subprojects such as design of the product, bidding from subcontractors to deliver goods to make the product, assembly of the product, various quality control checks of the product, and delivery of the product to the customer. This is only an example. A deliverable or project could comprise hundreds of task topics for that project. Tracking of the deliverable or project could be monitored by tracking the task topics.

"Task topic" is not merely a label. Likewise, a "reminder" is described in the specification for a task. A "task reminder" is not merely a label. The terms "task optic" and "task reminder" need to be given their broadest reasonable interpretation, but this interpretation needs to be consistent with the specification. It is wrong for the examiner to interpret these claim limitations ignoring their meaning as understood from reading the specification.

As further evidence that the examiner has not been using a proper "broadest reasonable interpretation" standard can be found on page 17 of the Examiner's Answer. In discussing claim 10 the examiner indicates that:

"The "communication tag information" is merely data."

Again, the examiner has not been giving claim limitations their proper meaning. The claim language must be interpreted

consistent with the specification. "communication tag information" is not merely data. The exact language is actually "communication tag information of a task tag" (see claim 1). This is data which relates information of a task tag; not any data.

As further evidence that the examiner has not been using a proper "broadest reasonable interpretation" standard can be found on page 20 of the Examiner's Answer. In discussing claim 16 the examiner indicates that:

"A voice mail message inherently is a telephone message converted to an electronic communication with voice recognition software."

This statement by the examiner is absurd. The members of the Board use telephones at the USPTO with voice mail capability which merely records messages. There is no voice recognition software being used. To state that a voice mail message inherently is a telephone message converted to an electronic communication with voice recognition software is clear not a reasonable statement. It is an unreasonable statement.

As further evidence that the examiner has not been properly reviewing the scope of the claims can be found on page 23 of the Examiner's Answer. In discussing claim 22 the examiner indicates that:

"Reed et al. at paragraph 0005 discloses user can be individuals..., which is also inherent, collaborators..., team leaders..., customers..."

Please note that claim 22 uses the transitional phrase "consisting of". MPEP 2111.03 clearly states that "The transitional phrase "consisting of" excludes any element, step, or ingredient not specified in the claim." There is no disclosure or suggestion in Reed et al. of "a group consisting of a combination of individuals, collaborators, team leaders, managers, and other computer programs" as recited in claim 22.

As further evidence that the examiner has not been using a proper "broadest reasonable interpretation" standard can be found on pages 23-24 of the Examiner's Answer. In discussing claim 23 the examiner indicates that:

"Also the creation of the preference values is inherent to the "task" on the "tag" of being set by a user. The system supports multiple users (see paragraph 0005) thus it is inherent this feature can be accomplished by user. The term "negotiated" has not been defined within the claim... The term 'negotiated" appears to be redundant to the term "setting"..."

The examiner has not provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. The claimed method of claim 23 merely states wherein an importance of the task on the tag is set and negotiated by the users. Thus, at least two users negotiate and set the importance of a task. There is nothing remotely similar to this in Reed et al. Plain meaning (MPEP 2111.01) of "negotiate" is to arrange or settle by discussion and mutual agreement. There is no type of

arrangement or settlement by discussion and mutual agreement disclosed or suggested in Reed et al.

Conclusion

In view of the arguments presented above, it is respectfully requested that the Examiner's rejections of Claims 1-36 be reversed.

Respectfully submitted,

Mark F. Harrington

Mark F. Harrington (Reg. No. 31,686)

6/8/10

Date

Customer No.: 29,683  
Harrington & Smith,  
Attorneys At Law, LLC  
4 Research Drive  
Shelton, CT 06484-6212  
203-925-9400

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